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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ACKUN, JACOB K

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,362

Applicant(s)

GOLDBERG, EDWARD

Examiner

Jacob K. Ackun Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-17 and 35-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Weiss et al. The reference appears to show a device having a body portion comprising an outside shell and at least one carabiner attachment. For example at least the flashlight embodiment has a tool (lightbulb or batteries) therein. The opening in flashlights is normally just large enough to accept batteries. Accordingly, claims such as claim 1 continue to read on Weiss in spite of the amendments made to the claims. Note also the comments in paragraph 5 below.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Jr., Jones or Lin in view of Weiss et al., Barber or applicants own disclosure of the prior art. Jones or Lin have most of the elements of the claims but lack a carabineer. Brown is also applied in this ground of rejection to the extent the applicant may argue that Brown does not disclose a carabineer. The secondary references including the applicant's own admission each make clear that it is conventional to attach a carabineer to a variety of small hand tools to increase their utility, such as by facilitating their attachment to something or someone. It would have been obvious in view of any one of the note secondary references to attach a carabineer having the

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claimed structure to the devices of either Lin, Jones or Brown (for example at either 36 or 64 of Brown), in order to facilitate the attachment of these devices elsewhere, thereby making the devices more useful. Note that Lin clearly teaches a screwdriver and tape measure, and that the tape measure of Jones meets the requirement for a tool.

5. Applicant's arguments filed on 06/20/2005 have been fully considered but they are not persuasive. Some claims continue to be anticipated by at least one reference as noted above. Note that the phrase pointed to by applicant "such that said tool extends from said body portion" is functional, and especially so based on how the claims are written. Functional recitations are considered to be met by the prior art if the prior art is deemed to be capable of the function, even though the prior art may not expressly teach the function. The batteries etc of Weiss are inherently capable of being made to extend from the body portion such as when they are half removed therefrom.

As to the obviousness issues the applicants arguments that the carabineers of Barber and Weiss are also used as handles is not convincing. Just because the carabineers also serve a second purpose does not make it unobvious to employ them in other prior art devices such as those of Jones or Lin. One having ordinary skill in the relevant art knows that carabineers do not have to be employed as handles to have utility. However the routineer might also want to modify Lin or Jones to add a combination carabineer and handle to these devices, not just the carabineer. After all, a flashlight of the type disclosed in Weiss or combination tool of the kind disclosed in Barber does not normally have a separate handle where the noted carabineers are situated. Additionally the applicant's argument does not address the rejection based on the combination

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including the applicants own disclosure of the prior art which indicates that carabineers are well known aside from the handle aspect.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (571)272-4418. The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571)272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacob K. Ackun Jr.
Primary Examiner
Art Unit 3723

J.A.